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McGinn & Gibb PLLC
Suite 304
2568 A Riva Road
Annapolis, MD 21401

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/863,921	MITTAL ET AL.	
Examiner	Art Unit	
John L Young	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG
PRIMARY EXAMINER
12/27/2004

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/27/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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NON-FINAL OFFICE ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

STATUS

2. Claims 1, 3-47 are pending.

CLAIM OBJECTIONS

3. Objections Withdrawn for claims 26 & 35.

4. Claim 12 is objected to for a typographical error. As per claim 12, at line 1 after the word “predetermined” delete the word “males” and insert the word –rules–.

5. Claims 26 & 27 are objected to because said claims lack positive structural connectivity for doing something and are unclear, because of the use of the phrase “adapted to. . . .” For

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example, in claim 27, at lines 6-7, the element of “wherein said code adapted to targeting one or more of a plurality of customers as recipients of the promotional offer. . . .” would be better stated as: “wherein said code targets one or more of a plurality of customers as recipients of the promotional offer. . . .”; therefore, in claim 7, at line 6 after the word “code” delete the phrase “adapted to targeting” and replace it with the word –targets–.

Appropriate corrections are required.

CLAIM REJECTIONS — 35 U.S.C. §101

6. Rejections Withdrawn.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3-47 are rejected under 35 U.S.C. §103(a) as being obvious over Chen US 6,741,969 (May 25, 2004) [US f/d: May 30, 2000] (herein referred to as “Chen”).

As per independent claim 1, Chen (col. 20, ll. 13-30) discloses: *“reward points may be used when accepting an offer. . . . For example, when a user accepts an offer . . . the user [gets] a 30% off discount provided the user spends \$40, the user also has the*

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option to redeem the reward points . . . and use them. . . . Thus, the user receives . . . a credit back from the incentive, and a credit back from the reward points."

Chen (col. 23, ll. 35-67; and col. 24, ll. 1-7) discloses: *"an adjustment of offer discount may be calculated by adjusting the original offer discount percent by the adjustment factor."*

Chen (col. 24, ll. 1-7) discloses: *"These offers may then be presented to the user where the user may accept the offer."*

Chen (col. 8, ll. 60-67; col. 9, ll. 1-10; and col. 3, ll. 20-40) discloses: *"The customer may . . . view a personalized auction list that tracks information . . . of particular interest to the customer. The personalized auction page may also monitor the customer's rewards, customer's profile and targeted marketing information which may include promotions or special offers . . . of interest to the customer. . . . and check on their rewards. . . ."*

Chen (the ABSTRACT; FIG. 1; FIG. 2a; FIG. 3a; FIG. 4; FIG. 6; FIG. 7; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 19; col. 1, ll. 50-60; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 8, ll. 60-67; col. 9, ll. 1-40; col. 20, ll. 13-30; col. 23, ll. 35-67; and col. 24, ll. 1-7) shows: A method of conducting a promotional offer over a computer network, the method comprising . . . targeting one or more of a plurality of customers as recipients of the promotional offer . . . wherein one or more of the unspecified or variable parameters associated with the offer are individually assigned for one or more of the

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targeted customers to whom the record of the offer is distributed, and wherein said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers.”

Chen lacks explicit recitation of: “defining the structure of said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable . . . and distributing a record of the promotional offer to the customers over said computer network. . . .”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Chen (col. 20, ll. 13-30) which discloses:

“reward points may be used when accepting an offer. . . . For example, when a user accepts an offer . . . the user [gets] a 30% off discount provided the user spends \$40, the user also has the option to redeem the reward points . . . and use them. . . . Thus, the user receives . . . a credit back from the incentive, and a credit back from the reward points. . . .” inherently shows: “defining the structure of said promotional offer having a

plurality of associated parameters, one or more of which are unspecified or variable. . . .”

because such an extensive percent discount scheme would have had to have defined structure; and

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Chen (col. 8, ll. 60-67; and col. 9, ll. 1-10) which discloses: *“The customer may . . . view a personalized auction list that tracks*

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information . . . of particular interest to the customer. The personalized auction page may also monitor the customer's rewards, customer's profile and targeted marketing information which may include promotions or special offers . . . of interest to the customer. . . ." implicitly shows: "distributing a record of the promotional offer to the customers over said computer network. . . ."; and it would have been obvious to modify and interpret the disclosure of Chen cited above as showing "defining the structure of said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable . . . and distributing a record of the promotional offer to the customers over said computer network. . . ." because modification and interpretation of the cited disclosure of Chen would have provided means to "*enable a user to participate in an auction for one or more gift certificates or merchandise. . . .*" (see Chen col. 1, ll. 64-67)) based on the motivation to modify Chen so as to "*facilitate marketing and promotion campaigns. . . .*" (see Chen (col. 3, ll. 65-67)).

As per dependent claim 3, Chen shows the method of claim 1.

Chen (col. 20, ll. 13-30) discloses: "*reward points may be used when accepting an offer. . . . For example, when a user accepts an offer . . . the user [gets] a 30% off discount provided the user spends \$40, the user also has the option to redeem the reward points . . . and use them. . . . Thus, the user receives . . . a credit back from the incentive, and a credit back from the reward points.*"

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Chen lacks explicit recitation of: “the unspecified or variable offer parameters are assigned default values.”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Chen (col. 20, ll. 13-30) inherently shows: “the unspecified or variable offer parameters are assigned default values. . . .” because such a percent discount scheme would have had to have defined a default structure; and it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify and interpret the disclosure of Chen cited above as showing “the unspecified or variable offer parameters are assigned default values. . . .” because modification and interpretation of the cited disclosure of Chen would have provided means to “*enable a user to participate in an auction for one or more gift certificates or merchandise. . . .*” (see Chen col. 1, ll. 64-67)) based on the motivation to modify Chen so as to “*facilitate marketing and promotion campaigns. . . .*” (see Chen (col. 3, ll. 65-67)).

As per dependent claim 4, Chen shows the method of claim 3.

Chen (col. 20, ll. 13-30) discloses: “*reward points may be used when accepting an offer. . . . For example, when a user accepts an offer . . . the user [gets] a 30% off discount provided the user spends \$40, the user also has the option to redeem the reward*

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points . . . and use them. . . . Thus, the user receives . . . a credit back from the incentive, and a credit back from the reward points.”

Chen lacks explicit recitation of: “default values can be changed a predetermined number of times.”

“Official Notice” is taken that both the concepts and the advantages of “default values can be changed a predetermined number of times. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art and it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify and interpret the disclosure of Chen cited above as showing “default values can be changed a predetermined number of times. . . .” because modification and interpretation of the cited disclosure of Chen would have provided means to “*enable a user to participate in an auction for one or more gift certificates or merchandise. . . .*” (see Chen col. 1, ll. 64-67)) based on the motivation to modify Chen so as to “*facilitate marketing and promotion campaigns. . . .*” (see Chen (col. 3, ll. 65-67)).

Dependent claim 5 is rejected at least for substantially the same reasons as claim 4.

Dependent claim 6 is rejected at least for substantially the same reasons as claim 3.

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Dependent claim 7 is rejected at least for substantially the same reasons as claim 1.

Dependent claim 8 is rejected at least for substantially the same reasons as claim 1.

Dependent claim 9 is rejected at least for substantially the same reasons as claim 1.

Dependent claim 10 is rejected at least for substantially the same reasons as dependent claim 3.

Dependent claim 11 is rejected at least for substantially the same reasons as dependent claim 3.

Dependent claim 12 is rejected at least for substantially the same reasons as dependent claim 3.

Dependent claim 13 is rejected at least for substantially the same reasons as dependent claim 3.

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Dependent claim 14 is rejected at least for substantially the same reasons as dependent claim 1.

Dependent claim 15 is rejected at least for substantially the same reasons as dependent claim 1.

As per dependent claim 16, Chen shows the method of claim 1.

Chen (col. 20, ll. 13-30) discloses: *“reward points may be used when accepting an offer. . . . For example, when a user accepts an offer . . . the user [gets] a 30% off discount provided the user spends \$40, the user also has the option to redeem the reward points . . . and use them. . . . Thus, the user receives . . . a credit back from the incentive, and a credit back from the reward points.”*

Chen lacks explicit recitation of the: “respective customers can decline . . . the offer.”

“Official Notice” is taken that both the concepts and the advantages the: “respective customers can decline . . . the offer. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art and it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify and interpret the disclosure of Chen cited above as

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showing the: “respective customers can decline . . . the offer. . . .” because modification and interpretation of the cited disclosure of Chen would have provided means to “*enable a user to participate in an auction for one or more gift certificates or merchandise. . . .*” (see Chen col. 1, ll. 64-67)) based on the motivation to modify Chen so as to “*facilitate marketing and promotion campaigns. . . .*” (see Chen (col. 3, ll. 65-67)).

As per dependent claim 17, Chen shows the method of claim 1.

Chen (col. 5, ll. 13-45; and col. 6, ll. 35-60) discloses: “*electronic certificates*” and “*paper certificate or coupon*”

Chen lacks explicit recitation of: “an electronic coupon.”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Chen (col. 5, ll. 13-45; col. 6, ll. 35-60; col. 8, ll. 60-67; and col. 9, ll. 1-10)) implicitly shows: “wherein the record of the offer is an electronic coupon. . . .”; and it would have been obvious to modify and interpret the disclosure of Chen cited above as implicitly showing: “wherein the record of the offer is an electronic coupon. . . .” because modification and interpretation of the cited disclosure of Chen would have provided means to “*enable a user to participate in an auction for one or more gift certificates or merchandise. . . .*” (see Chen col. 1, ll. 64-67)) based on

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the motivation to modify Chen so as to “*facilitate marketing and promotion campaigns. . . .*” (see Chen (col. 3, ll. 65-67)).

Dependent claim 18 is rejected at least for substantially the same reasons as dependent claim 1.

As per dependent claims 19-20, Chen shows the method of claim 6.

Chen (col. 20, ll. 13-30) discloses: “*reward points may be used when accepting an offer. . . . For example, when a user accepts an offer . . . the user [gets] a 30% off discount provided the user spends \$40, the user also has the option to redeem the reward points . . . and use them. . . . Thus, the user receives . . . a credit back from the incentive, and a credit back from the reward points.*”

Chen lacks explicit recitation of the: “the customer’s utility for the promoted product of the product identifier information exceeds that of the customer’s corresponding preferred brand product. . . .[claim 19]” and “offer discount information is determined for each customer as the difference in price between the promoted product of the product identifier information and the customer’s corresponding preferred brand product. . . .[claim 20].”

“Official Notice” is taken that both the concepts and the advantages of “the customer’s utility for the promoted product of the product identifier information exceeds

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that of the customer's corresponding preferred brand product. . . .[claim 19]" and "offer discount information is determined for each customer as the difference in price between the promoted product of the product identifier information and the customer's corresponding preferred brand product. . . .[claim 20]. . . ." were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art and it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify and interpret the disclosure of Chen cited above as showing "the customer's utility for the promoted product of the product identifier information exceeds that of the customer's corresponding preferred brand product. . . .[claim 19]" and "offer discount information is determined for each customer as the difference in price between the promoted product of the product identifier information and the customer's corresponding preferred brand product. . . .[claim 20]" because modification and interpretation of the cited disclosure of Chen would have provided means to "*enable a user to participate in an auction for one or more gift certificates or merchandise. . . .*" (see Chen col. 1, ll. 64-67)) based on the motivation to modify Chen so as to "*facilitate marketing and promotion campaigns. . . .*" (see Chen (col. 3, ll. 65-67)).

As per dependent claim 21, Chen shows the method of claim 6.

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Chen (the ABSTRACT; col. 20, ll. 13-30; and whole document) shows an:

“unspecified or variable parameter of offer. . . .”

Chen lacks explicit recitation of the: “offer validity period is determined for each customer as at least the period to the estimated time of the customer’s next purchase.”

“Official Notice” is taken that both the concepts and the advantages of the: “offer validity period is determined for each customer as at least the period to the estimated time of the customer’s next purchase. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art and it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify and interpret the disclosure of Chen cited above as showing the: “offer validity period is determined for each customer as at least the period to the estimated time of the customer’s next purchase. . . .” because modification and interpretation of the cited disclosure of Chen would have provided means to “*enable a user to participate in an auction for one or more gift certificates or merchandise. . . .*” (see Chen col. 1, ll. 64-67)) based on the motivation to modify Chen so as to “*facilitate marketing and promotion campaigns. . . .*” (see Chen (col. 3, ll. 65-67)).

Independent claim 22 is rejected for at least substantially the same reasons as independent claim 1.

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Independent claim 23 is rejected for at least substantially the same reasons as independent claim 1.

Independent claim 24 is rejected for at least substantially the same reasons as independent claim 1.

Independent claim 25 is rejected for at least substantially the same reasons as independent claim 1.

Independent claim 26 is rejected for the same reasons as independent claim 1.

Independent claim 27 is rejected for the same reasons as independent claim 1.

Independent claim 28 is rejected for at least substantially the same reasons as independent claim 1.

Claim 29 is rejected for substantially the same reasons as claim 3.

Claim 30 is rejected for substantially the same reasons as claim 4.

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Claim 31 is rejected for substantially the same reasons as claim 5.

Claim 32 is rejected for substantially the same reasons as claim 6.

Claim 33 is rejected for substantially the same reasons as claim 7.

Claim 34 is rejected for substantially the same reasons as claim 8.

Claim 35 is rejected for substantially the same reasons as claim 9.

Claim 36 is rejected for substantially the same reasons as claim 10.

Claim 37 is rejected for substantially the same reasons as claim 11.

Claim 38 is rejected for substantially the same reasons as claim 12.

Claim 39 is rejected for substantially the same reasons as claim 13.

Claim 40 is rejected for substantially the same reasons as claim 14.

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Claim 41 is rejected for substantially the same reasons as claim 15.

Claim 42 is rejected for substantially the same reasons as claim 16.

Claim 43 is rejected for substantially the same reasons as claim 17.

Claim 44 is rejected for substantially the same reasons as claim 18.

Claim 45 is rejected for substantially the same reasons as claim 19.

Claim 46 is rejected for substantially the same reasons as claim 20.

Claim 47 is rejected for substantially the same reasons as claim 21.

RESPONSE TO ARGUMENTS

8. Applicant's arguments (filed 10/20/2004) have been considered but are not persuasive for the following reasons:

Applicant's arguments are moot based on new grounds of rejection presented in the instant Office action.

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CONCLUSION

9. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or

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proceeding should be directed to the Group receptionist whose telephone number is (703)
305-3900.


John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

December 27, 2004